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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,980	01/31/2001	Shigeo Murase	Q61602	2642
7590	03/09/2005		EXAMINER	
SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue, N.W. Washington, DC 20037			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)	
09/772,980	MURASE, SHIGEO	
Examiner	Art Unit	
JAGDISH PATEL	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 31 January 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 31 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    Paper No(s)/Mail Date. \_\_\_\_\_.  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 10/28/2002.                    5) Notice of Informal Patent Application (PTO-152)  
     6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This office action responds to claims as amended in the preliminary amendment filed with the application dated 01/31/01. Accordingly claims 1-8 are currently pending and have been examined.

***Information Disclosure Statement***

2. The information disclosure statement filed 10/28/2002 fails to comply with 37 CFR 1.98(a)(3)(i) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Note that only the foreign patents without translation as required are not considered.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 and 7-8 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 5 recites "the use charges are paid by using a prepaid card". This limitation renders claim 5 indefinite because there is no feature of the system which interfaces with a prepaid card. The billing unit only calculates use charge based on the integration of the Internet use charge.

Claim 7 recites "financial institution" and "user's account". There is no elements recited in the system claims 1, 6 or 7 which identify the financial institution and the user's account". In absence of specific elements which facilitate receipt of this information the claim 7 is indefinite.

Claim 8 recites "the use charges are paid in cash" which renders the claim indefinite because the no feature of the system which interfaces with a cash payment means.

***Claim Rejections - 35 USC § 102***

5. A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

6. Claims 1, 2, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by USUAI.

As per Claim 1 Usui teaches an automated billing type information providing system comprising:

a monitor loaned to a user and connected to a provider through a telecommunication line via a server; (see Figure 2 personal computer which is connected to the Internet through a modem)

a signal receiving unit for receiving video signals output to said monitor; (see Figure 2 personal computer which connected to the Internet.)

and

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a billing unit for integrating Internet use time through the telecommunication line or projection time for which the video signals are projected on said monitor through said signal receiving unit, and calculating a use charge based on a result of this integration,

wherein a user pays the use charge calculated by said billing unit and is thereby allowed to utilize the Internet through the telecommunication line and to at least view the video signals on said monitor.

(see Fee-charging server on Figure 2 and at least see col. 2 L 62- col. 3 L 7 "calculating access charges according to the amount of access time each client used")

Claim 2. wherein the telecommunication line is composed of a LAN system.

(see Modem in Figure 2 and see col. 1 "third-person service")

Claim 6. wherein said billing unit is constructed so that the result of the integration are transmitted to said provider through the telecommunication line, and the user is billed for the use charges based on the results of the integration transmitted to said provider.

(see "access charges according to the amount of the access time", col. 3 L 1-7)

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. §103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 -5 are rejected under 35 U.S.C. §103 being unpatentable over Usui.

Regarding Claims 3-5. wherein said monitors are installed in individual homes, and said server for a plurality of homes is

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provided outside the homes, wherein a plurality of said monitors are installed in a hospital ward, and said server is also installed in the ward. Usui fails to teach that the claimed system and/or its constituent parts are installed at the specified locations. However, since the operation or the functionality of the operation are not modified by the recited location(s) as recited in the claims, it would have been obvious to one of ordinary skill in the art to install the monitors and the server at the desired locations.

See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.)

Claim 5 is similarly analyzed as per claims 3 and 4 because it also concerns location of the monitor.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

3/7/05